

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

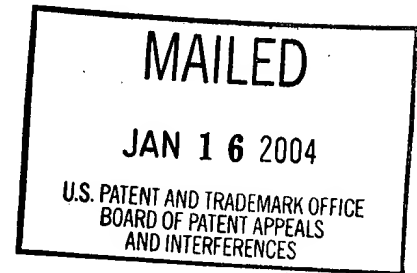
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOHN W. CHRISMAN III

Appeal No. 2004-0139
Application No. 09/832,141

ON BRIEF



Before GARRIS, TIMM, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO EXAMINER

The above-identified application is hereby remanded to the examiner via the Office of the Director for Technology Center 3700 for appropriate action consistent with our comments below.

Via the answer, the examiner has advanced on this appeal two rejections. The examiner has expressed his statements of these rejections as follows:

Claims 1-3, 5, 7, 8, 10-27, 29 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over what is old and well known in bowling balls in view of Shibantai [answer, page 2]), [and]

Claims 9, 32 and 33 are rejected under
35 U.S.C. § 103(a) as being unpatentable
over bowling balls in view of Shibanaï and
further in view of Anderson [answer, page 3].

For a number of reasons, these rejections are not ripe for appeal to this Board.

First, the examiner has not adequately identified the subject matter upon which he relies in his aforequoted references to “what is old and well known in bowling balls” (answer, page 2) and “bowling balls” (answer, page 3). With apparent reference to this subject matter, the examiner refers to disclosure “at the bottom of pg. 2 of Appellant’s specification” (answer, page 2). However, this general reference to the “bottom” of specification page 2 lacks the specificity required to particularly identify the subject matter which the examiner considers admitted prior art and which the examiner relies upon in the rejections before us.

Concerning this last-mentioned point, we emphasize that a pivotal issue raised by the appellant and by the examiner involves the claim requirement concerning a “two-part resin” (e.g., see appealed independent claim 1). Significantly, at the bottom of specification page 2 and more precisely in the paragraph bridging specification pages 2 and 3, the appellant seems to admit that it was known in the prior art to make bowling balls from polyurethanes which are then described in a fashion consistent with the “two-part resin” feature here claimed. Therefore, upon return of this application to the Examining Corps, the examiner should confirm with the appellant whether the disclosure bridging pages 2 and 3 of the specification constitutes admitted prior art vis-à-vis the use of a two-part resin, namely, polyurethanes for making bowling balls. Further, the examiner should clarify by specification page and line number the precise disclosure

which is relied upon in his rejections as admitted prior art including, if appropriate, the disclosure bridging specification pages 2 and 3.

In addition, the previously quoted statements of rejections in the answer do not include the Coffey patent and therefore are inconsistent with the statements of rejections which appear in the Final Office Action (i.e., paper number 10) and similarly are inconsistent with the listing of prior art on page 2 of the answer (i.e., since this listing includes reference to the Coffey patent). On the record before us, it is unclear whether the statements of rejections in the answer fail to include the Coffey patent due to inadvertent oversight or due to deliberate intent by the examiner. It follows that the examiner must clarify this matter on the application file record.

The record advanced by the examiner's answer contains another infirmity of critical importance. Specifically, the examiner in his answer has relied upon numerous references in support of his obviousness conclusions, which have not been included in his statements of rejections. These references include the aforementioned Coffey patent as well as the Edwards and Wilbert patents of record (e.g., see the paragraph bridging pages 2 and 3 of the answer). Likewise, the examiner has relied upon the "Handbook of Reinforced Plastics" (see the last full paragraph on page 4 of the answer) as well as literature (which may or may not be prior art) obtained from two websites (see the first full paragraph on page 5 of the answer).

It has long been established that, where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n. 3. Also see the Manual of Patent Examining Procedures (MPEP) Section

706.02(j) (revision 1, February 2003). For this reason, it is clear that the examiner inappropriately relied upon the above-discussed references to support his obviousness conclusions. Therefore, the examiner should reconsider the pending prior art rejections and, as appropriate, modify them so that the statements of these rejections include all of the prior art references which are relied upon.

With further regard to the previously mentioned Edwards patent (i.e., patent number 4,513,014), we emphasize to the examiner as well as to the appellant that this reference appears to disclose an article of manufacture in the form of a chewable toy for an animal which is made from a two-part resin, that is, polyurethane which contains a flavor, odor or aroma extract (e.g., see lines 30-55 in column 5, lines 28-59 in column 6, the paragraph bridging columns 6 and 7 as well as lines 18-28 in column 7). In light of the Edwards disclosure, this patent appears to be anticipatory with respect to at least appealed independent claim 27 and to be highly relevant with respect to the other appealed claims. Accordingly, in reconsidering his rejections of the now-pending claims, the examiner should carefully evaluate the propriety of rejecting one or more of these claims based on the Edwards patent alone or in combination with other prior art.

It is our determination that the above-discussed infirmities of record can not be rectified in the form of a supplemental examiner's answer. Therefore, we will not authorize the examiner to prepare a supplemental examiner's answer. It follows that these infirmities must be corrected in the form of reopened prosecution by the examiner.

This application, by virtue of its "special" status, requires an immediate action;
see MPEP Section 708.01(D). It is important that the Board be promptly informed of any
action affecting the appeal in this case.



Bradley R. Garriss
Administrative Patent Judge



Catherine Timm
Administrative Patent Judge



Beverly A. Pawlikowski
Administrative Patent Judge

)
)
)
)
)
) BOARD OF
) PATENT
)
) APPEALS AND
)
) INTERFERENCES
)
)
)

eld

Appeal No. 2004-0139
Application No. 09/832,141

Page 6

Brick G. Powe
Trask, Britt & Rossa Law Offices
P. O. Box 2550
Salt Lake City, UT 84110